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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Montefiore Medical Center

Serial No. 76589284

Anthony J. Casella of Casella & Hespos for Montefiore Medical Center.

Jason F. Turner, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Seeherman, Hairston and Walsh, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Montefiore Medical Center has appealed from the final refusal of the Trademark Examining Attorney to register BRIDGING THE GAP BETWEEN EDUCATION AND PRACTICE, in standard character form, as a mark for the following services:

Educational services, namely, arranging and conducting classes, seminars, conferences, demonstrations and workshops in the field of medicine, and

distributing course materials in connection therewith.¹

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the previously registered mark BRIDGING THE GAP BETWEEN SCIENCE AND PRACTICE, also in standard character form, for, inter alia, "development and dissemination of educational materials in the field of sports medicine; educational services, namely, arranging and conducting classes, seminars, conferences and workshops in the field of sports medicine; and educational testing services"² that, as used in connection with applicant's services, it is likely to cause confusion or mistake or to deceive.

The appeal has been fully briefed. An oral hearing was not requested.

We affirm the refusal of registration.

We turn first to a procedural matter. With its response to the first Office action, applicant submitted a

¹ Application Serial No. 76589284, filed April 29, 2004, and asserting first use and first use in commerce as of January 1, 2004.

² Registration No. 2619404, issued September 17, 2002. The registration also includes the following goods in Class 16: "printed instructional, educational, and teaching materials in the field of sports medicine." However, it is clear from the Examining Attorney's comments that the refusal is based on likelihood of confusion in connection with the services identified in the cited registration.

list of third-party applications and registrations taken from the USPTO TESS database. The list consists simply of the application and/or registration number, the word mark, and the status of the application or registration, i.e., whether it is "live" or "dead." In the second Office action, the Examining Attorney advised applicant that merely submitting such a list was not an acceptable way to make the registrations of record. Applicant did not subsequently submit copies of the registrations or applications themselves. With its appeal brief applicant attached as an exhibit another list, which contains some of the same third-party applications and registrations, but appears to be an updated list, since the list submitted with the response to the Office action has a date at the bottom of April 26, 2004, and the list submitted with the appeal brief has a date of March 1, 2006. In his appeal brief, the Examining Attorney has objected to consideration of the exhibit attached to applicant's appeal brief as untimely, and has objected to the earlier submitted list as being incompetent to prove the existence of the registrations and applications. We sustain the objections to both lists.

Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of

an appeal. Thus, the list applicant submitted as an exhibit to its appeal brief is manifestly untimely, and will not be considered. As for the list applicant submitted during the prosecution of its application, such a listing of registration/application numbers and marks is insufficient to make the registrations and applications of record. See TBMP Section 1208.02 and cases cited therein. We note that the Examining Attorney stated, in advising applicant that the listing was insufficient, that a trademark search report is not credible evidence of the existence of the registrations listed in the report, and we further note that the list was not a private company's search report, but was obtained from the USPTO's database. However, the Examining Attorney did make clear that to properly make registrations of record, copies of the registrations themselves, or the electronic equivalent thereof, would have to be submitted. Thus, applicant was on notice that its submission was insufficient, and applicant made no effort to cure that insufficiency. Accordingly, we have not considered the list as showing the existence of third-party applications or registrations.³

³ Even if the list were considered, it would have no effect on our decision herein. The third-party applications on the list have virtually no probative value; actual copies of the applications would show only that the applications had been filed. As for the registrations, applicant points to only six

This brings us to the substantive issue on appeal: whether applicant's use of BRIDGING THE GAP BETWEEN EDUCATION AND PRACTICE in connection with its identified educational services is likely to cause confusion with the registrant's mark BRIDGING THE GAP BETWEEN SCIENCE AND PRACTICE for its services. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

third-party registrations which it states "are in International Class 41 relating to educational services." Brief, p. 7. However, we cannot ascertain from the list that was submitted that these registrations are in Class 41, or that they relate to educational services in general or, more importantly, to educational services that are similar to those identified in the application and the cited registration. Thus, we would not have been able to accept applicant's argument that these registrations show that the BRIDGING THE GAP portion of the cited mark is highly suggestive or descriptive, or otherwise weak.

Applicant's services are identified as "educational services, namely, arranging and conducting classes, seminars, conferences, demonstrations and workshops in the field of medicine, and distributing course materials in connection therewith." The identification of services in the cited registration is "development and dissemination of educational materials in the field of sports medicine; educational services, namely, arranging and conducting classes, seminars, conferences and workshops in the field of sports medicine; and educational testing services." The language in the two identifications are practically the same, e.g., educational services, namely, arranging and conducting classes, seminars, conferences and workshops" (applicant's identification also lists "demonstrations"). In addition, both parties' identifications include the provision of educational materials; while applicant's identification uses the phrase "distributing course materials in connection therewith" and the cited registration uses the word "dissemination," these terms are synonyms and identify the same service. We note that the cited registration confines the educational services to the field of sports medicine, while applicant's services are identified as being in the field of "medicine," without any limitation as to the specific type of medicine. Because

the field of "medicine" per se would encompass the field of "sports medicine," applicant's and the registrant's services must be deemed to be, in part, identical.

Applicant does not argue otherwise, but confines its arguments to the differences in the marks, and asserts that the marks are sufficiently different to avoid a likelihood of confusion. Applicant primarily bases this argument on its assertion that the BRIDGING THE GAP portion of the marks is "a common phrase, found in many registered trademarks, and is therefore, a weak element of both the applicant's mark and cited registration." Brief, p. 6. As a result, applicant argues that "applicant's mark and the cited registration should not be viewed as including the phrase "BRIDGING THE GAP," but should be viewed from the standpoint of whether or not "EDUCATION AND PRACTICE" is confusingly similar to "SCIENCE AND PRACTICE." Brief, p. 7.

We are not persuaded by applicant's position. First, as noted above, applicant has not made of record any third-party registrations that would indicate that BRIDGING THE GAP has a suggestive (or descriptive) meaning in connection with educational services in the field of medicine or, for that matter, any educational services. Secondly, even if there had been such evidence, it is not permissible to

ignore part of a mark, even if that portion is suggestive or descriptive. While it is permissible to accord less weight to a highly suggestive or descriptive portion, marks must still be compared in their entirety. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

When we compare the marks in their entirety, the similarities between them are striking. They both use the same phrasing and structure, beginning with BRIDGING THE GAP BETWEEN and ending with two concept words, the second of which is PRACTICE, which is the last word in both marks. Thus, the marks are identical except for the fact that the fifth word of applicant's mark is EDUCATION while the fifth word of the registered mark is SCIENCE. We acknowledge that the words EDUCATION and SCIENCE are different words, having different appearances, pronunciations and meanings. However, it is not whether there are differences in these specific words, but whether the marks as a whole are sufficiently different that must concern us. Overall we find that the marks are very similar in appearance, sound, meaning and commercial impression. Under actual marketing conditions, purchasers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v.*

Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). Because of the overall similarity of the marks, purchasers are likely not to note the difference in the single word EDUCATION/SCIENCE found in the marks or to remember this difference. To the extent that purchasers would note the difference, they are likely to view applicant's mark BRIDGING THE GAP BETWEEN EDUCATION AND PRACTICE as a variation of the mark BRIDGING THE GAP BETWEEN SCIENCE AND PRACTICE, and see both marks as identifying services emanating from a single source.

The du Pont factors of the similarity of the marks and the similarity of the services thus favor a finding of likelihood of confusion.

Applicant and the Examining Attorney have not discussed any of the remaining du Pont factors. To the extent that any are applicable, they must be considered to be neutral. After considering all of the relevant du Pont factors, we find that the use of applicant's mark for its services is likely to cause confusion with the cited registration.

Decision: The refusal of registration is affirmed.